



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/730,383      | 12/06/2000  | Celso Candido De Souza | TPL 119             | 7406             |

23995 7590 11/03/2004

RABIN & Berdo, PC  
1101 14TH STREET, NW  
SUITE 500  
WASHINGTON, DC 20005

|          |
|----------|
| EXAMINER |
|----------|

BORLINGHAUS, JASON M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3628

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/730,383

Applicant(s)

DE SOUZA ET AL.

Examiner

Jason M. Borlinghaus

Art Unit

3628



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/6/00.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1 – 17 are objected to because of the following informalities: There are numerous places lacking antecedent basis. For example, Claim 1 cannot be clearly understood when the applicant uses the phrase “the fee,” as no prior mention of a fee was made. Additionally, Claim 3 cannot be clearly understood as it is unclear whether the applicant is referring to the before mentioned e-commerce system when the applicant states “an e-commerce system” or another, as yet unmentioned, e-commerce system. Examiner suggests that the applicant replace “an” with “the” for the purpose of improving clarity. Examiner suggests that the applicant review all the claims for further needed corrections.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3628

3. Claims 1 – 2, 6, 8 – 12 and 17 - 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin (U.S. Patent 6,338,050) in view of Frison (U.S. Patent 6,049,789).

Regarding Claim 1, Conklin discloses an e-commerce system, the method comprising:

- creating a record of usage (history) of the e-commerce system for each system user based on transactional documents transmitted in the e-commerce system (“appropriate records to document each stage of interaction and negotiation”) (see col. 14, lines 24 – 28); and
- storing the record of usage (history) on a computer readable medium (internal databases) (see col. 14, lines 24 – 28).

Conklin does not teach:

- retrieving the record of usage in a periodic manner;
- electronically creating an invoice based on the record of usage, wherein the fee established in the invoice is dependent upon system usage by each system user; and
- invoicing the system users.

Frison discloses an e-commerce system, the method comprising:

- retrieving the record of usage (usage data) in a periodic manner (“periodically send state and usage data”) (see col. 4, lines 10 – 12);
- electronically creating an invoice based on the record of usage (“process the stored usage data to generate usage reports and/or invoices”);

Art Unit: 3628

wherein the fee established in the invoice is dependent upon system usage by each system user (see col. 5, lines 6 – 8); and

- invoicing the system users (“forwarded to licensees”) (see col. 5, lines 7 – 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by incorporating an invoicing system using the record of usage, as was done by Frison, to provide further integration of the e-commerce system.

Regarding Claim 2, Conklin does not teach that the invoicing is performed via electronic mail.

Frison discloses that the invoicing is performed via electronic mail (“forwarded to licensees electronically”) (see col. 5, lines 7 – 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by transmitting invoices electronically, as was done by Frison, to provide quicker transmission of the invoice.

Regarding Claim 6, Conklin discloses that the record of usage (history) comprises the type of transaction document, the date and time of transmission of the transactional document, and the addressee of the transactional document for each transactional document (“appropriate documents to document each stage of interaction and negotiation”) (see col. 14, lines 24 – 28).

Regarding Claim 8, Conklin does not teach that the record of usage is stored in a database on one or more servers in the Internet.

Frison discloses that the record of usage (usage record) is stored in a database (usage database) on one or more servers in the Internet (see col.3, lines 21 – 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by having the record of usage stored in a database on one or more servers in the Internet, as was done by Frison, to allow for quick and easy retrieval of the record of usage for billing purposes.

Regarding Claim 9, Conklin does not teach that the record of usage is retrieved by a software agent loaded on the server side of the e-commerce system.

Frison discloses that the record of usage (usage record) is retrieved (sent) by a software agent (PPU licensing monitor) loaded on the server side of the e-commerce system (see col. 4, lines 22 – 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by having the record of usage retrieved by a software agent loaded on the server side of the e-commerce system, as was done by Frison, allowing for regular and routine retrieval of the record of usage for billing purposes.

Regarding Claim 10, Conklin discloses that the record of usage (history) comprises a record of requests for quotation, submitted quotations, submitted proposals, signed contracts for sale or purchase, purchase orders under contract, and one-time purchase orders ("appropriate documents to document each stage of interaction and negotiation") (see col. 14, lines 24 – 28).

Regarding Claim 11, Conklin discloses a method for billing users of an e-commerce system, the method comprising:

- creating a record of usage (history) of the e-commerce system by each system user based on transactional documents transmitted in the e-commerce side (“appropriate records to document each stage of interaction and negotiation”) on the server side of an e-commerce system (see col. 14, lines 24 – 28); and
- compiling the record of usage (history) in a database (internal databases) (see col. 14, lines 24 – 28).

Conklin does not teach:

- extracting usage information in a periodic manner;
- electronically creating an invoice wherein the fee established in the invoice is dependent upon system usage by each system user; and
- invoicing the system users.

Frison discloses a method for billing users of an e-commerce system, the method comprising:

- extracting usage (usage data) information in a periodic manner (“periodically send state and usage data”) (see col. 4, lines 10 – 12);
- electronically creating an invoice (“process the stored usage data to generate usage reports and/or invoices”) wherein the fee established in the invoice is dependent upon system usage by each system user; and

Art Unit: 3628

- invoicing the system users ("forwarded to licensees") (see col. 5, lines 7 – 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by incorporating an invoicing system using the record of usage, as was done by Frison, to provide further integration of the e-commerce system.

Neither Conklin nor Frison explicitly disclose:

- combining usage information (usage data) with pricing information and transaction documents ("appropriate records to document each stage of interaction and negotiation"), which have been accounted for to determine the usage fees for each user on the server side of an e-commerce system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by combining the usage information with pricing informational and transaction documents, to provide an additional level of integration of the e-commerce system.

Regarding Claim 12, Conklin does not teach that the invoicing is performed via electronic mail.

Frison discloses that the invoicing is performed via electronic mail ("forwarded to licensees electronically") (see col. 5, lines 7 – 9).



It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by transmitting invoices electronically, as was done by Frison, to provide quicker transmission of the invoice.

Regarding Claim 17, Conklin discloses that the record of usage (history) comprises a record of requests for quotation, submitted quotations, submitted proposals, signed contracts for sale or purchase, purchase orders under contract, and one-time purchase orders ("appropriate documents to document each stage of interaction and negotiation") (see col. 14, lines 24 – 28).

Regarding Claim 18, Conklin discloses a method for performing e-commerce transactions, comprising the steps of:

- creating a record of usage (history) of the e-commerce system for each system user based on transactional documents transmitted in the e-commerce system ("appropriate records to document each stage of interaction and negotiation") (see col. 14, lines 24 – 28); and
- storing the record of usage (history) on a computer readable medium (internal databases) (see col. 14, lines 24 – 28).

Conklin does not teach:

- retrieving the record of usage in a periodic manner;
- electronically creating an invoice based on the record of usage, wherein the fee established in the invoice is dependent upon system usage by each system user; and
- invoicing the system users.

Art Unit: 3628

Frison discloses a method for performing e-commerce transactions, comprising the steps of:

- retrieving the record of usage (usage data) in a periodic manner (“periodically send state and usage data”) (see col. 4, lines 10 – 12);
- electronically creating an invoice based on the record of usage (“process the stored usage data to generate usage reports and/or invoices”); wherein the fee established in the invoice is dependent upon system usage by each system user (see col. 5, lines 6 – 8); and
- invoicing the system users (“forwarded to licensees”) (see col. 5, lines 7 – 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by incorporating an invoicing system using the record of usage, as was done by Frison, to provide further integration of the e-commerce system.

4. Claims 3 – 5 and 13 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin in view of Frison as applied to Claims 1 and 11 above, and further in view of Egendorf (U.S. Patent 5,794,221).

Regarding Claim 3, neither Conklin nor Frison teach that the invoicing is performed by a third party incorporating fees for usage of an e-commerce system into the third party's billing.

Egendorf discloses that the invoicing is performed by a third party incorporating fees for usage of an e-commerce system into the third party's billing (see col. 6, lines 37 – 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin and Frison by allowing third party invoicing, as was done by Egendorf, to provide users of the e-commerce system the ability to outsource the invoicing process.

Regarding Claim 4, neither Conklin nor Frison teach that the third party is a telecommunication service provider.

Egendorf discloses that the third party is a telecommunication service provider (telephone company) (see col. 6, lines 40 – 46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin and Frison by allowing the third party to be a telecommunication service provider, as was done by Egendorf, since telecommunication service providers, by their very nature, would already be participating in e-commerce activities.

Regarding Claim 5, neither Conklin nor Frison teach that the third party is a banking institution.

Egendorf discloses that the third party is a banking institution (bank) (see col. 6, lines 37 – 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin and Frison by allowing the third party to

Art Unit: 3628

be a banking institution, as was done by Egendorf, since banking institutions, by their very nature, maintained the banking accounts of participants in e-commerce activities.

Regarding Claim 13, neither Conklin nor Frison teach that the invoicing is performed by a third party incorporating fees for usage of an e-commerce system into the third party's billing.

Egendorf discloses that the invoicing is performed by a third party incorporating fees for usage of an e-commerce system into the third party's billing (see col. 6, lines 37 – 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin and Frison by allowing third party invoicing, as was done by Egendorf, to provide users of the e-commerce system the ability to outsource the invoicing process.

Regarding Claim 14, neither Conklin nor Frison teach that the third party is a telecommunication service provider.

Egendorf discloses that the third party is a telecommunication service provider (telephone company) (see col. 6, lines 40 – 46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin and Frison by allowing the third party to be a telecommunication service provider, as was done by Egendorf, since telecommunication service providers, by their very nature, would already be participating in e-commerce activities.

Art Unit: 3628

Regarding Claim 15, neither Conklin nor Frison teach that the third party is a banking institution.

Egendorf discloses that the third party is a banking institution (bank) (see col. 6, lines 37 – 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin and Frison by allowing the third party to be a banking institution, as was done by Egendorf, since banking institutions, by their very nature, maintained the banking accounts of participants in e-commerce activities.

Regarding Claim 16, Conklin discloses that the database (internal databases) comprises the total number of remitted documents by document type for the period of records (“appropriate records to document each stage of interaction and negotiation”) (see. col. 14, lines 24 – 28).

Conklin does not teach a database comprising the time period of the set of records contained therein, the name of the user's base where the billing is being made, the present size of the server side user's database, and the average size of the server side user's database.

Frison discloses a database (usage database) comprising the time period of the set of records (date, time) and the name of the user's base where the billing is being made (host, user) (see col. 3, lines 63 – 66).

Egendorf discloses a database (host computer) comprising the present size of the server side user's database and the average size of the server side of user's

Art Unit: 3628

database ("host computer logs billing data, CPU time, storage type and usage") (see col. 45, lines 29 – 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin by combining the number of remitted documents with the time period of the set of documents and the name of the user's base, as was done by Frison, and the size of database, as was done by Egendorf, to provide an additional level of integration of the e-commerce system.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin view of Frison as applied to Claim 6 above, and further in view of Crawford (U.S. Patent 5,771,354).

Regarding Claim 7, neither Conklin nor Frison teach a record of usage that further comprises the amount of memory consumed by each server side user's database.

Crawford discloses a record of usage (billing data) that further comprises the amount of memory (storage) consumed by each server side user's database (see col. 58, lines 40 – 45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Conklin and Frison by having a record of usage that further comprises the amount of memory consumed by each server side user's database, as was done by Crawford, to provide another statistic by which to generate revenue.

### ***Conclusion***


Art Unit: 3628

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (703) 308-9552. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\*

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600